No. 80-1384

In the Supreme Court of the United States

October Term, 1980

JOSEPH JOHN SHINDELAR,
Petitioner,

vs.

ADIN F. HOLDEMAN, ET AL.,
Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR RESPONDENTS IN OPPOSITION

STEPHEN D. TIMMONS
Counsel of Record
GORDON D. SCHMIDT
SCHMIDT, JOHNSON, HOVEY & WILLIAMS
1400 Mercantile Bank Building
1101 Walnut Street
Kansas City, Missouri 64106
(816) 474-9050
Counsel for Respondents

E. L. MERRIWETHER, INC., 920 Cherry Street, Kansas City, Mo. 64106, (816) 471-9050

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Respondents agree that this Court has jurisdiction to consider the Petition for Writ of Certiorari under 28 U.S.C. §1256. However, this case presents no Constitutional Issues or other questions of law worthy of this Court's attention. The facts, as found by the Board of Patent Interferences and unanimously affirmed by the Court of Customs and Patent Appeals, dictate the application of well established, easily applied principles of law.

This case was routinely decided below in the normal, ordinary way without calling upon any novel point of

law or creating any conflict of law. Petitioner simply failed to meet his factual, evidentiary burdens. Even now, Petitioner fails to face the facts as found below and forces us to supply those pivotal items which are conspicuously missing or misstated in Petitioner's statement of the case.

COUNTER-STATEMENT OF THE CASE

Beginning January 1973 (after making and testing a machine employing the invention, Appendix A of the petition, p. 3a) Petitioner secretly embarked upon a dilatory course of conduct that spanned almost two and one-half years before finally ending the delay and filing his patent application on June 11, 1975 (Appendix A of the petition, p. 4a). Nowhere in the record is there any evidence whatsoever that Petitioner publicly disclosed his invention during those years or that the secrecy and delay were anything other than wholly voluntary. "During this period, the only work in any way connected with the invention was the making of a novelty and invention search and the preparation of a patent application, no actual work having been performed on the invention itself" (Appendix A of the petition, p. 20a). As noted by the Court below, "more than two years of the delay period remains unaccounted for. Apparently, due to the patent attorney's workload, the Shindelar application merely lay dormant in Deere's patent department for at least two years" (Appendix A of the petition, p. 8a).

Meanwhile, during the period that Petitioner was delaying, Respondent moved ahead and filed its own application before Petitioner (on June 9, 1975) but coincidently claiming the same invention (Appendix A of the petition, p. 3a). Consequently, an "interference" was later declared by the Patent and Trademark Office to determine which

of the two rival parties was to be "awarded priority of invention" (Appendix A of the petition, p. 3a).

The Court below, affirming the Board's decision, held that "Under the facts of this case, which are simple, undisputed and based on a very short record, and in light of the public policy inherent in 35 U.S.C. §102(g), we hold that the evidence has raised an inference of suppression of the invention by Shindelar's assignee (Deere) which has not been rebutted." (Appendix A of the petition, p. 6a). "The decision of the board awarding priority to Holdeman, et al. is affirmed." (Appendix A of the petition, p. 10a).

ARGUMENT

The facts as above enumerated are routinely simple to apply to the controlling interference statute, 35 U.S.C. §102(g), whose Constitutionality Petitioner does not attack:

> "A person (Holdeman, et al.) shall be entitled to a patent unless—
>
> (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it."

Thus, if Petitioner "had not abandoned, suppressed, or concealed" the invention, he might have been entitled to the patent rather than the earlier filing Holdeman, et al. on the basis that Petitioner "made" it first. But instead, Petitioner's only evidence showed secrecy, prolonged delay and a conscious election by Petitioner's corporate patent staff to work on other projects, raising a clear inference of "suppression or concealment" that Petitioner failed to rebut.

Absolutely false is the disturbing claim by Petitioner (p. 11 of the petition) that "It is undisputed that Deere & Company did not intend to suppress the invention." Indeed, Respondent has vigorously disputed that very point from the outset. And directly contrary is the above-noted holding by the Court below "that the evidence has raised an inference of suppression of the invention by Shindelar's assignee (Deere) which has not been rebutted." (Appendix A of the petition, p. 6a). Although Petitioner claims it "always intended to file the application", it is manifest, as observed by the Court below, that "the showing of an intent to file—someday—[will not] negative a holding of suppression." (Appendix A of the petition, p. 9a).

Neither the Board nor the Court below committed any error in law. Indeed, Petitioner's remarks to the contrary notwithstanding, the Court below scrupulously avoided even the slightest impression that it was "law-making":

> "we caution that any attempt to establish a rule that a certain specified length of time is per se unreasonable is contrary to the previous holdings of this court. We reiterate that each case involving the issue of suppression or concealment must be considered on its own particular set of facts." (Appendix A of the petition, p. 10a).

Petitioner lost on the *facts*. It is as simple as that. When Petitioner by his own evidence established that the invention was kept secret and filing of the patent application was put off almost two and one-half years after the invention was supposedly perfected, his suspicious behavior demanded a legitimate explanation.

But instead of offering acceptable excuses, Petitioner merely contended that the corporate patent staff of the

giant Deere & Company corporation was too busy working on other matters to devote attention to the project. Consequently, the dilatory conduct could be treated as nothing else than an unlawful suppression or concealment.

Petitioner makes considerable effort to fabricate the illusion that the Court below has effectively established a "first-to-file" system in this country, i.e., that the inventor who files first will always be awarded the patent as against another inventor who files second. To the contrary, the Court below has carefully adhered to the case law and statutory requirements of 35 U.S.C. §102(g) which expressly forbid awarding the patent right to another, earlier inventor unless he is someone who "had not abandoned, suppressed, or concealed it". See *Kendall v. Winsor*, 62 U.S. 322, 328 (1858) in which this Court forcefully declares that he who unfairly "withholds his invention from the public comes not within the policy or objects of the Constitution or acts by Congress" but, rather functions to "impede the progress of science and the useful arts." Also, see *Peeler v. Miller*, 535 F.2d 647 (C.C.P.A. 1976); *Horwath v. Lee*, 564 F.2d 948 (C.C.P.A. 1977); and *Young v. Dworkin*, 489 F.2d 1277 (C.C.P.A. 1974).

This is nothing more than the simple application of well established law—it does not even begin to approach unauthorized "law-making" by the Court below. Indeed, it is Petitioner who would have this Court indulge in law-making of its own by asking to ignore and effectively strike "who had not abandoned, suppressed, or concealed it" from §102(g) in order that Petitioner might prevail.

Petitioner further claims that the Court below has created some kind of horrible "prompt filing" rule by holding that Petitioner "suppressed or concealed" the invention. As should be apparent to all concerned, this is sim-

ply not true since it is not the time or lack of promptness per se that decides the case, but rather Petitioner's lack of acceptable excuse for the excessive delay. The fact that Petitioner took almost two and one-half years to file the application after supposedly reducing the invention to practice would be totally irrelevant if Petitioner had only presented satisfactory evidence rebutting the inference of suppression created by his own delaying conduct.

CONCLUSION

Petitioner's arguments merely evidence his desire to have one last review of the facts of this case. This is clearly not a valid ground or sufficient justification for Writ of Certiorari. *Magnum Co. v. Coty*, 262 U.S. 159, 163 (1925); *Layne & Bowler Corporation v. Western Well Works, Inc., et al.*, 261 U.S. 387, 393 (1923); *Forsyth v. Hammond*, 166 U.S. 506, 514 (1896).

Respectfully submitted,

STEPHEN D. TIMMONS
Counsel of Record
GORDON D. SCHMIDT
SCHMIDT, JOHNSON, HOVEY & WILLIAMS
1400 Mercantile Bank Building
1101 Walnut Street
Kansas City, Missouri 64106
(816) 474-9050
Counsel for Respondents